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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,043	09/22/2003	Alan Eskuri	1001.1700101	7847
28075	7590	09/25/2007	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC			APANIUS, MICHAEL	
1221 NICOLLET AVENUE			ART UNIT	PAPER NUMBER
SUITE 800			3736	
MINNEAPOLIS, MN 55403-2420			MAIL DATE	DELIVERY MODE
			09/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/667,043	ESKURI, ALAN
Examiner	Art Unit	
Michael Apanius	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 16 July 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-9,11,13-16,18-26 and 30 is/are pending in the application.  
4a) Of the above claim(s) 5-7,18,20 and 21 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4,8,9,11,13-16,19,22-26 and 30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. The amendments to claims 1, 11, 13, 16, 22, 25 and 26; the addition of new claim 30; the cancellation of claims 10, 12, 17 and 27-29; and the amendments to the specification are acknowledged.

### ***Claim Objections***

2. Claims 22-26 and 30 are objected to because of the following informalities. At claim 16, it appears that "a stainless steel" should be --stainless steel--. At the second to last line of claim 22, "the proximal end of the coil tip" appears to lack proper antecedent basis in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Palermo et al. (US 5,769,796). Palermo discloses a guidewire (figures 5A and 5B)

comprising: an elongated inner core member including a proximal section (102) and a distal section, the distal section including a proximal portion (122, 130) and a distal portion (134); an elongated reinforcing member (132) having a proximal end and a distal end, the elongated reinforcing member disposed about the proximal portion of the distal section such that the distal portion of the distal section is free of the reinforcing member; and an outer coil member (112) having a proximal end and a distal end, the outer coil member disposed about the distal section of the core member, there being no intervening layer of material between the distal portion of the distal section and the outer member; where the proximal end of the outer coil member is located proximal of the proximal end of the elongated reinforcing member. The distal portion of the distal section of the core member has a non-circular cross-section (column 6, lines 63-67). The core member comprises stainless steel (column 7, lines 14-18).

5. Claims 13-16 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Reynolds et al. (US 7,074,197). Reynolds discloses a guidewire (figure 11) comprising: an elongated inner core member including stainless steel (column 9, lines 17-18), the inner core member including a proximal portion (314) having a first cross-sectional area, an intermediate portion (316) having a second cross-sectional area, wherein the second cross-sectional area is less than the first cross-sectional area, and a distal portion (358) having a ribbon profile; an elongated tubular member (390) including a nickel-titanium alloy (column 12, line 22; column 13, lines 58-61), the tubular member having a proximal end and a distal end, the tubular member being disposed

about the intermediate portion of the inner core member; and a coil tip (380) including stainless steel (column 12, lines 18-19), the coil tip extending over the distal portion of the inner core member and the tubular member; wherein the proximal end of the coil tip is located proximal of the proximal end of the tubular member. A portion of the intermediate and distal portion of the core member includes stainless steel (as noted above). A diameter of the intermediate portion is less than a diameter of the proximal portion. An outside diameter of the coil tip is substantially equal to a diameter of the proximal portion.

6. The applied reference appears to have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo et al. (US 5,769,796) in view of O'Connor et al. (US 6,887,235).
9. Palermo discloses that the reinforcing member may be constructed of a suitable metallic material (column 6, lines 60-62) but does not expressly disclose that the reinforcing member is a tube having at least one cut or groove or is made of a nickel-titanium alloy.
10. O'Connor teaches a reinforcing member with a helical groove (40 in figure 3A) or a plurality of cuts (44, 46 in figure 4A) for the purpose of providing desired torque and flexibility characteristics to the reinforcing member without requiring additional components (column 2, lines 23-26).
11. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a nickel-titanium alloy tube having at least one helical groove as taught by O'Connor as the reinforcing member of Palermo in order to provide a reinforcing member with desired torque and flexibility characteristics without requiring additional components.
12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo et al. (US 5,769,796) in view of Urick et al. (US 5,666,969).
13. Palermo discloses that the outer member is a coil formed of radiopaque material (column 6, lines 7-13) but does not expressly disclose that the coil is made from stainless steel.

14. Urick teaches making a distal coil from stainless steel in order to provide significantly differing degrees of radiopacity (abstract, lines 9-11) such that the ease and accuracy of locating the guidewire is improved (column 4, lines 20-23).

15. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a stainless steel coil as taught by Urick in the guidewire of Quiachon in order to provide significantly differing degrees of radiopacity such that the ease and accuracy of locating the guidewire is improved.

16. Claims 19, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (US 7,074,197) in view of O'Connor et al. (US 6,887,235).

17. Reynolds does not expressly disclose that the reinforcing member is a tube having at least one helical cut or groove.

18. O'Connor teaches a reinforcing member with a helical groove (40 in figure 3A) or a plurality of cuts (44, 46 in figure 4A) for the purpose of providing desired torque and flexibility characteristics to the reinforcing member without requiring additional components (column 2, lines 23-26).

19. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have provided the reinforcing member of Reynolds with a helical groove as taught by O'Connor in order to provide desired torque and flexibility characteristics to the reinforcing member without requiring additional components.

***Response to Arguments***

20. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

  
MAX HINDENBURG  
CONTENT EXAMINER  
ART CENTER 3700